

MONTHLY INTELLECTUAL PROPERTY RIGHTS NEWSLETTER

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Dear Readers,

We bring you a concise analysis of important developments, recent publications and judgements and noteworthy regulatory amendments in the corporate and financial sectors on a monthly basis.

Our newsletter outlines various developments and significant legal and cultural milestones that highlights the importance of preserving and protecting Intellectual Property rights.

Perceiving the significance of these updates and the need to keep track of the same, we have prepared this newsletter providing a concise overview of the various changes brought in by our proactive regulatory authorities and the Courts!

Feedback and suggestions from our readers would be appreciated. Please feel free to write to us at mail@lexport.in.

Regards,
Team Lexport



ABOUT US

Lexport is a full-service Indian law firm offering consulting, litigation and representation services to a range of clients.

The core competencies of our firm's practice *inter alia* are Trade Laws (Customs, GST & Foreign Trade Policy), Corporate and Commercial Laws and Intellectual Property Rights.

The firm also provides Transaction, Regulatory and Compliance Services. Our detailed profile can be seen at our website www.lexport.in.

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INDEX

Delhi High Court Restores Davidoff Trademark, Sets Aside IPAB's Removal Order Over Procedural Lapse	...2-3
The Hon'ble Delhi High Court has ruled against renowned Indian songwriter A.R. Rahman, holding him liable for copyright infringement and ordering a deposit of Rs. 2 crores and payment of Rs. 2 Lakhs in damages..	...3
L'Oreal Secures Victory Against Delhi Counterfeiters in Major Trademark Infringement Case	...4
Calcutta High Court Upholds Natural Justice in Patent Rejection: Fresh Review Ordered on Nicotine Aerosol Device under Section 3(b)	...4-5
Delhi High Court Rejects RCB's Plea Against Uber Moto's Humorous IPL Advertisement	...5
Commerce Ministry Forms Expert Panel to Study AI's Impact on Copyright Law	...6
Article: Innovation Vs. Litigation: Patent Disputes in the Tech World	...6

PART A: COURT RULINGS

Issue 1: Delhi High Court Restores Davidoff Trademark, Sets Aside IPAB's Removal Order Over Procedural Lapse

Ruling: The case of *M/s Zine Davidoff SA v. Union of India and Anr* involved a war over the trademark 'DAVIDOFF' owned by the Swiss luxury brand, Zine Davidoff SA. The Petitioner had submitted the application for registration of the trademark in 1986, which would have lapsed in 1993. The registration certificate had actually been granted in 1997. The Petitioner had filed the application for the renewal of the trademark in 1998 on the premise that it was well within the statutory six months window. Later renewals were done in the year 2001, and the Petitioner claimed that the trademark was renewed validly and that it did not expire.

The Intellectual Property Appellate Board (IPAB) erased the trademark from the register, asserting that it was outdated owing to a lapse in renewal. The IPAB held that the trademark was outdated and hence directed its erasure, although the Petitioner had applied for renewal within time. The root cause was the Trade Marks Registry's omission to serve a compulsory Form O-3 notice prior to expunging the trademark. Such a notice is mandatory under Section 25 of the Trade Marks Act, 1958 and Rule 64 of the Trade Marks Rules, 1959 as a notification to the trademark holder of the forthcoming expiration date of the trademark and the obligation to renew the same.

The Delhi High Court, after looking into the case, decided in Favor of the Petitioner, Zine Davidoff SA. The Court held that the Trade Marks Registry had acknowledged the fact that they had no records showing that notice for the required form was issued to the petitioner. The Court emphasized the fact that the giving of notice in Form O-3 is a procedural mandate and that the non-adherence to this procedure should not hold the petitioner back. Consequently, the Court reinstated the 'DAVIDOFF' trademark to its original position in the register, overruling the order of the IPAB and dismissing the petition of the petitioner.

M/S Zine Davidoff S.A. vs Union of India and Anr. W.P.(C)-IPD 57/2021

***Lexport Comments:-** The Delhi High Court's ruling in Zine Davidoff SA v. Union of India rightly highlights the importance of procedural fairness in trademark law. The decision reaffirms that mandatory procedural requirements, like issuing Form O-3 notices, cannot be bypassed by administrative oversight. The judgment strengthens the principle that procedural lapses by authorities cannot defeat a rightful claim.*

Issue 2: The Hon'ble Delhi High Court has ruled against renowned Indian songwriter A.R. Rahman, holding him liable for copyright infringement and ordering a deposit of Rs. 2 crores and payment of Rs. 2 Lakhs in damages.

Ruling: Ustad Faiyaz Wasifuddin Dagar, the son and heir of Junior Dagar Brothers, sued celebrated composer A.R. Rahman and others for copyright infringement relating to the song "Veera Raja Veera" from the film Ponniyin Selvan: II. The matter arose after Dagar claimed that Rahman's song illegally borrowed an original musical piece, "Shiva Stuti" composed by the Junior Dagar Brothers in the 1970s, without permission. Despite Dagar's prior notice to the Defendants regarding the infringement, there was no response, leading to the present lawsuit. The Defendants argued that the composition was traditional and already part of the public domain, but the Court ultimately sided with Dagar, affirming the originality of the Junior Dagar Brothers' work and awarding him Rs. 2 crores. The Delhi High Court ruled in favor of Ustad Faiyaz Wasifuddin Dagar, holding that the original composition was protected by copyright.

The Court found that the Defendants, including A.R. Rahman, had access to the original "Shiva Stuti" and that their song "Veera Raja Veera" was substantially similar, amounting to copyright infringement. Rejecting the argument that the composition was public domain material, the Court directed that credits be given to the Junior Dagar Brothers as original composers of "Shiva Stuti" wherever "Veera Raja Veera" appears. It also ordered the Defendants to deposit ₹2 crores as security for potential damages and awarded ₹2 lakhs in costs to the Plaintiff.

Ustad Faiyaz Wasifuddin Dagar v. A.R. Rahman & Ors., CS(COMM) 773/2023, (Del. HC Apr. 25, 2025)(India).

***Lexport Comments:-** The Delhi High Court's ruling is a strong affirmation of protecting original artistic expression, even against big names like A.R. Rahman. It rightly recognized that the Junior Dagar Brothers' "Shiva Stuti" was not just traditional material but a unique creation deserving copyright protection. Awarding Rs. 2 crores highlights the seriousness of infringement and sends a clear message: creativity must be respected, and proper permissions are essential. This judgment is an important win for preserving artistic integrity and cultural heritage, and it sets a powerful precedent for cases involving reinterpretation of classical or traditional compositions.*

Issue 3: L'Oreal Secures Victory Against Delhi Counterfeiters in Major Trademark Infringement Case

Ruling: The trademark infringement case between L'Oreal and two Delhi based retailers concluded on 30 April 2025 with the court ruling in favor of the Plaintiff. The suit originated on 10 November 2017, as a "*John Doe*" case when L'Oreal sought to protect its registered trademarks including L'OREAL, MAYBELLINE, and GARNIER against unknown counterfeiters in Delhi's Sadar Bazar market. Acting on L'Oreal's application, the court appointed a Local Commissioner on 13 December 2017, who conducted raids that uncovered substantial quantities of counterfeit cosmetics from Anup Jain's Lahore Shop (S.K. Traders). Though both defendants initially contested the allegations by filing written statements challenging the court's territorial jurisdiction and denying trademark infringement, they subsequently abandoned their defence and were declared ex-parte on 30 January, 2025. The court, drawing on precedents including *Burger King Corporation v. Techchand Shewakramani* and *Imagine Marketing Pvt. Ltd. v. Green Accessories*, determined it had sufficient evidence to rule without requiring additional ex-parte testimony from L'Oreal. In its judgment, the court affirmed L'Oreal's ownership of the disputed trademarks and found overwhelming evidence that the defendants had infringed these registered marks by manufacturing and selling counterfeit products. The court cited Sections 28 and 29 of the Trademarks Act, 1999, which establish exclusive rights for trademark owners and define infringement as using identical or deceptively similar marks in relation to the same category of goods.

The final decree granted L'Oreal a permanent injunction against both defendants, prohibiting them from manufacturing, storing, or selling any counterfeit products bearing L'Oreal's trademarks or logos. The court also ordered the defendants to pay the costs of the suit and directed that all seized counterfeit products be delivered to L'Oreal for destruction. However, despite the substantial counterfeiting operation uncovered, the court declined to award monetary damages, citing insufficient evidence regarding either the profits earned by the defendants or specific financial losses suffered by L'Oreal from these activities.

M/S L'Oreal v. Jain, TM No. 327/2021, CNR No. DLND01-014831-2017 (Dist. Ct. Delhi Apr. 30, 2025) (India).

Lexport Comments:- The case L'Oréal v. Anup Jain emphasises the importance of protecting intellectual property, particularly in cases of counterfeit goods. L'Oréal accused Anup Jain of selling counterfeit products, and the court ruled in Favor of the brand, emphasizing the harm caused to both consumers and the brand's reputation. The judgment highlights the necessity of strong legal frameworks to protect trademarks and prevent the spread of counterfeit products.

PART B: ARTICLES AND NEWS

1. Calcutta High Court Upholds Natural Justice in Patent Rejection: Fresh Review Ordered on Nicotine Aerosol Device under Section 3(b)

The Calcutta High Court ruled in *ITC Limited vs The Controller of Patents* to set aside the order of the Assistant Controller of Patent rejecting the Appellant's patent application. The appellant was denied natural justice as the Assistant Controller relied on documents that weren't mentioned in the First Examination Report or adequately distinguished in the hearing notice. The court further noted that section 3(b) of The Indian Patents Act, 1970 focuses on 'intent' rather than effect. International agreements like TRIPS and the Paris Convention discourage denying patents solely because commercial exploitation is prohibited by domestic law. The court remanded the case for fresh consideration within six months by a different officer, who must make an independent decision without being influenced by observations in this ruling.

2. Delhi High Court Rejects RCB's Plea Against Uber Moto's Humorous IPL Advertisement

In Royal Challengers Sports Private Limited v. Uber India & Ors., the Delhi High Court ruled on a case where Royal Challengers Bengaluru (RCB) brought a suit against Uber Moto in relation to its YouTube advertisement “Baddies in Bengaluru ft. Travis Head”. Few Screenshots of the Ad is produced herein below for reference:



In the advertisement, Sunrisers Hyderabad cricketer Travis Head spray-paints ‘*Royally Challenged Bengaluru*’ on the sign of the Bengaluru cricket stadium, and RCB objected that it was disparaging its trademark. RCB accused Sunrisers Hyderabad's sponsor Uber Moto of utilizing a deceptively similar variant of RCB's trademark for business purposes, damaging the reputation of their brand. RCB wanted a preliminary injunction to prohibit the advertisement on the grounds that it was disparagement, misrepresentation, and unfair commercial use. In defence, Uber's attorney claimed that the advertisement was nothing but a joke during the IPL match between RCB and Sunrisers Hyderabad and aimed to promote the services of Uber Moto and fell within commercial

free speech. Justice Saurabh Banerjee rejected RCB's application for interim injunction and held that the advertisement was not harmful to the trademark of RCB. The Court regarded the ad as a light-hearted, humorous utterance, and not one disparaging in nature. It held that there was no *prima facie* case of harm to RCB's reputation, and that the use of the trademark was not equivalent to defamation, gain by unfair means, or harm to RCB's reputation. The Court reaffirmed that the ad was a healthy ribbing in the environment of a sporting event and rejected the application, allowing the advertisement to continue airing.

3. Commerce Ministry Forms Expert Panel to Study AI's Impact on Copyright Law

In a major step to tackle the new challenges being raised by artificial intelligence (AI), the Ministry of Commerce has established a specialized committee of eight experts. According to an internal (non-public) note, the committee was formed last month with the task of closely studying the interface of AI and India's copyright regime. The panel's primary responsibility is to "*analyze and identify the legal and policy issues raised by the application of artificial intelligence to copyright*". This would entail determining where AI-work is placed within the existing copyright law, determining whether the present law sufficiently responds to the emerging technologies, and proposing future reform to integrate AI-developments into the existing systems. The move is indicative of increasing worldwide apprehension over the ownership, novelty, and safeguard of works produced with the help or direct participation of AI technologies. India's initiative tries to make its regime on copyright relevant and strong in the wake of quick technological advancements.

4. Article: Innovation Vs. Litigation: Patent Disputes in the Tech World

In this article, our Partner, Ms. Rajlatha Kotni, along with Associate Ms. Swagita Pandey and Intern Mr. Rakesh Kumar Vatsa explores the escalating role of patent litigation in the global technology sector, focusing on landmark disputes involving Apple, Samsung, Microsoft, Motorola, Ericsson, and Xiaomi. The Article examines the legal complexities of design patents, standard-essential patents (SEPs), and FRAND obligations.

Link: <https://shorturl.at/Aja8Z>

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